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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,515	07/10/2006	Janne Kristian Suotula	3772-33	5880

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EXAMINER
WOOLCOCK, MADHU

ART UNIT	PAPER NUMBER
2451	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/585,515	SUOTULA ET AL.
	Examiner	Art Unit	
	MADHU WOOLCOCK	2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>16 March 2010</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-4,9 and 13</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-4,9 and 13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>10 July 2006</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>07/10/2006</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This communication is in response to claims 1-4, 9 and 13 filed on 03/16/2010.

Information Disclosure Statement

2.   The information disclosure statement filed 07/10/2006 fails to comply with 37

CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document;

each non-patent literature publication or that portion which caused it to be listed; and all

other information or that portion which caused it to be listed. It has been placed in the

application file, but the information referred to therein has not been considered.

Drawings

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because reference character "1", "2", "3" and "4" has been used to designate both the

Proxy CSCF, the IMS, a user terminal and the packet switched access network,

respectively, of FIG. 1, as described in paragraph [0005], and the IP based networks of

FIG. 2, as described in paragraph [0007]. Corrected drawing sheets in compliance with

37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: FIG. 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or

amendment to the specification to add the reference character(s) in the description in

compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action. The objection to the drawings will not be held in abeyance.

5.   Figures 1-4 should be designated by a legend such as --Prior Art-- because only

that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. The replacement sheet(s) should be labeled

"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office

action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

6.   Claim 1 recites the limitation "the SIP message" in the second limitation. There

is insufficient antecedent basis for this limitation in the claim. It is unclear whether this

is intended as referring to the previous recitation of "the message".

7.   Claim 2 recites the limitation "the address of a terminal user". There is

insufficient antecedent basis for this limitation in the claim.

8.   Claim 3 recites the limitation "the SIP exploder". However, claim 1, from which

claim 3 depends, comprises a first SIP exploder and a further SIP exploder. It is

unclear which SIP exploder is being referred to.

9.   Claim 3 recites the limitation "the exploder". There is insufficient antecedent

basis for this limitation in the claim. It is unclear whether this is intended as referring to

the previous recitation of "the SIP exploder".

10.   Claim 4 recites the limitation "the same network domain as the first exploder".

There is insufficient antecedent basis for this limitation in the claim.

11.   Claim 4 recites the limitation "the first exploder". There is insufficient antecedent

basis for this limitation in the claim. It is unclear whether this is intended as referring to

the previous recitation of "a first SIP exploder" in claim 1, from which claim 4 depends.

12.   Claim 4 recites the limitation "the terminal user destination addresses". There is

insufficient antecedent basis for this limitation in the claim.

13.   Claim 4 recites "a list associated with the same network domain as the first

exploder, determining the terminal user destination addresses of the list and delivering

the message individually to these addresses and to other user terminal destination

addresses in the same domain". The delivering of the message individually to "these

addresses" is interpreted as the terminal user addresses within the same domain, given

that the list is associated with the same domain. It is therefore unclear if there is a

distinction between these terminal user address and the claimed "other user terminal

destination addresses in the same domain". For purposes of examination they are both

interpreted to be destination addresses within the same domain as the first exploder.

14.   Claim 9 includes means plus function language, and therefore invokes 35

U.S.C. 112, sixth paragraph, however the specification provides no support or structural

description of the means for performing the claimed functions.

15.   Claims 9 and 13 recite the limitation "the AS" in the preamble. There is

insufficient antecedent basis for this limitation in the claim.

16.   Claims 9 and 13 recite the limitation "the message" in the third limitation. There

is insufficient antecedent basis for this limitation in the claim. It is unclear whether this

is intended as referring to the previous recitation of "the SIP message".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

17.   Claims 9 and 13 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to nonstatutory subject matter. Specifically, the body of the apparatus claims

including "receiving", "grouping" and "forwarding" are non-structural limitations, as they

could be implemented with software and are not specifically linked to any structural

element. Therefore, the claimed subject matter as a whole fails to fall within the

definition of a process, machine, manufacture or composition of matter, patentable

eligible category subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18.   Claims 1-4, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mostafa (US 2002/0087549) in view of Applicant's admitted prior art (referred to as

APA herein).

Regarding claim 1, Mostafa teaches a method of delivering a copy of a message to

each of a plurality of terminals in a multimedia communication system, the method

comprising:

receiving the message at a first relay (MMS user agent A then sends the message to MMS relay A through MNW A, [0096]);

grouping destination addresses defined for the message according to their network domains (on receiving the multimedia message, MMS relay A determines, from the addressing information included with the message, the intended recipient is not an MMS user agent of MMSE A but an MMS user agent of MMS relay B, [0098]); and

for each group of destination addresses corresponding to a domain associated with a further relay, forwarding a single copy of the message to that exploder, the message containing all of the destination addresses of the group (forwards the multimedia message to MMS relay B, [0098]; the MMS server maintains a list of recipients, [0117]).

However, Mostafa does not explicitly disclose a SIP message or a SIP exploder.

APA teaches a method of delivering a copy of a Session Initiation Protocol, SIP message (the base protocol for multimedia services is the IETF Session Initiation Protocol (SIP), [0002]), the method comprising SIP exploders (each network comprising a SIP exploder, [0007]).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize SIP exploders in the system/method of Mostafa as suggested by APA in order to efficiently transmit multimedia messages to a plurality of receivers. One would be motivated to combine these teachings because it would implement a well known technique for distributing the same multimedia message to a number of destinations, as taught by Mostafa.

Regarding claim 2, Mostafa teaches a method according to claim 1, wherein a destination address is the address of a terminal user or an identification of a list of terminal users and/or other lists (The data message is addressed to at least one recipient (e.g. MMS user agent B), [0116]).

Regarding claim 3, Mostafa does not explicitly disclose a method according to claim 1, wherein the SIP exploder is an application server which receives and sends SIP messages via a SIP proxy server, the SIP proxy server selectively forwarding SIP messages to the exploder according to some pre-defined rule set.

APA teaches wherein the SIP exploder is an application server which receives and sends SIP messages via a SIP proxy server (The SIP exploder introduced above is implemented in such an AS, [0006]), the SIP proxy server selectively forwarding SIP messages to the exploder according to some pre-defined rule set (Exploder 1 provides the exploder service to that terminal, i.e., sending a copy of the SIP message to each of the entries in the list, [0008]).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize SIP exploders in the system/method of Mostafa as suggested by APA in order to efficiently transmit multimedia messages to a plurality of receivers. One would be motivated to combine these teachings because it would implement a well known technique for distributing the same multimedia message to a number of destinations, as taught by Mostafa.

Regarding claim 4, Mostafa teaches a method according to claim 1 and comprising, for each destination address identifying a list associated with the same network domain as the first exploder (If the recipient MMS user agent were in the same MMSE, MMS Relay A would store the media content in MMS server A, [0007]), determining the terminal user destination addresses of the list and delivering the message individually to these addresses and to other user terminal destination addresses in the same domain (Upon receiving the notification, the recipient MMS user agent would retrieve the media content from the server via the MMS Relay, [0007]).

Regarding claim 9, Mostafa teaches an Application Server for use in a multimedia communication system, the AS comprising:

    means coupled to an input for receiving a message (MMS user agent A then sends the message to MMS relay A through MNW A, [0096]);

    means for grouping destination addresses defined for the message according to their network domains (on receiving the multimedia message, MMS relay A determines, from the addressing information included with the message, the intended recipient is not an MMS user agent of MMSE A but an MMS user agent of MMS relay B, [0098]); and

    means coupled to an output and arranged, for each group of destination addresses corresponding to a domain associated with a further exploder, to forward a single copy of the message to that exploder, the message containing all of the

destination addresses of the group (forwards the multimedia message to MMS relay B, [0098]; the MMS server maintains a list of recipients, [0117]).

However, Mostafa does not explicitly disclose a Session Initiation Protocol Application Server or that the message is a SIP message .

APA teaches a Session Initiation Protocol Application Server (The SIP exploder introduced above is implemented in such an AS, [0006]); and

SIP messages (the base protocol for multimedia services is the IETF Session Initiation Protocol (SIP), [0002]).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize SIP exploders implemented as application servers in the system/method of Mostafa as suggested by APA in order to efficiently transmit multimedia messages to a plurality of receivers. One would be motivated to combine these teachings because it would implement a well known technique for distributing the same multimedia message to a number of destinations, as taught by Mostafa.

Regarding claim 13, Mostafa teaches an Application Server for use in a multimedia communication system, the AS comprising electronic circuitry configured to:

receive a message (MMS user agent A then sends the message to MMS relay A through MNW A, [0096]);

group destination addresses defined for the message according to their network domains (on receiving the multimedia message, MMS relay A determines, from the

addressing information included with the message, the intended recipient is not an MMS

user agent of MMSE A but an MMS user agent of MMS relay B, [0098]); and

forward, for each group of destination addresses corresponding to a domain

associated with a further exploder, a single copy of the message to that exploder, the

message containing all of the destination addresses of the group. (forwards the

multimedia message to MMS relay B, [0098]; the MMS server maintains a list of

recipients, [0117]).

However, Mostafa does not explicitly disclose a Session Initiation Protocol

Application Server or that the message is a SIP message .

APA teaches a Session Initiation Protocol Application Server (The SIP exploder

introduced above is implemented in such an AS, [0006]); and

SIP messages (the base protocol for multimedia services is the IETF Session

Initiation Protocol (SIP), [0002]).

It would have been obvious to one of ordinary skill in the art at the time of the

claimed invention to utilize SIP exploders implemented as application servers in the

system/method of Mostafa as suggested by APA in order to efficiently transmit

multimedia messages to a plurality of receivers. One would be motivated to combine

these teachings because it would implement a well known technique for distributing the

same multimedia message to a number of destinations, as taught by Mostafa.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dorenbsoch (US 2003/0095510)

Rooke et al. (US 2005/0198161)

Fenton et al. (US 2003/0193951).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADHU WOOLCOCK whose telephone number is (571)270-3629. The examiner can normally be reached on Monday-Thursday 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. W./
Examiner, Art Unit 2451
/John Follansbee/
Supervisory Patent Examiner, Art Unit 2451